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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/138,209 08/24/98 POEL

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HM22/0404
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INTELLECTUAL PROPERTY LEGAL SERVICES
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EXAMINER

COLEMAN, B

ART UNIT

PAPER NUMBER

1624

7

DATE MAILED:

04/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/138,209

Applicant(s)

POEL et al.

Examiner
Brenda Coleman

Group Art Unit
1624



☒ Responsive to communication(s) filed on Jul 16, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) 7 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5 and 8-13 is/are rejected.

☒ Claim(s) 6 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claims 1-13 are pending in the application.

Election/Restriction

1. Applicant's election without traverse of Group III in Paper No. 6 is acknowledged.
2. Claim 7 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 6.
3. Claims 1-5 and 8-13 are rejected as being an improper Markush grouping. The recited compounds, while possessing a common utility, present a variable core and, thus, the Markush groups represented by the terms n and m, where n + m has variably different definitions, render the claims clearly improper.

Deletion of non-elected subject matter would overcome this rejection.

Information Disclosure Statement

4. The information disclosure statement filed December 7, 1998 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

One of the references was not available to the examiner. A copy of the references labeled AL, i.e. FR 2 500 450 A1 on the 1449 would be appreciated to complete the record.

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Oath/Declaration

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the order of the inventors originally set forth in the inventor information sheet does not match the order of the inventors set forth in the declaration. The first inventor was established as Toni-Jo Poel in the Transmittal of a Non-Provisional Application under 37 CFR 1.53(b)(1) filed August 24, 1998. All correspondents sent after the filing date of the application, i.e. August 24, 1998 indicate that the applicant(s) are Toni-Jo Poel et al., however, the declaration filed March 2, 1999 indicates that Richard Charles Thomas is the first inventor. See MPEP 605.04(f).

Claim Objections

6. Claim 1 is objected to because of the following informalities: claim 1 contains a typographical error in that the definition of the dotted line -----, where the dotted line ----- in the ring system of Formula I is a single or a double **bound**. Appropriate correction is required.

7. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art of record nor a search in the pertinent art area teaches the piperidinyl or hydrogenated pyridinyl compounds of the instant invention.


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8. Applicants' attention is directed to U.S. Patent No. 5,981,528, which while not competent as a reference against the instant claims, claims subject matter that is similar and/or identical to that claimed herein. Two patents cannot issue on the same subject matter, unless applicants can demonstrate that the claims are patentably distinct from the claims of this US patent, the only way to overcome this patent is by way of Interference proceedings or removal of the conflicting subject matter. See MPEP 2306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Monday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.


Brenda Coleman
March 29, 2000